

REMARKS

Claims 1-3, 10-19, and 23-39 were rejected and remain pending. Claim 1 has been amended merely to correct an obvious typographical error. Reconsideration and allowance are respectfully requested.

Summary of Interview

Applicants thank Examiner Michael J. Fisher for the time that he spent discussing the outstanding office action with applicants' attorney Marc E. Brown over the telephone on June 2, 2011.

During this interview, the patentability of claim 1 was discussed in light of the applied reference. No agreement was reached.

Claim Rejections – 35 USC § 103

Claims 1-3, 10-17, 20, 23-35, and 38-39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wanker (U.S. Patent 7,302,429). Reconsideration and allowance are requested.

Claim 1 recites an automated method for referring prospective customers to automobile dealers. In the past, prospective customers were referred to the dealer that was closest to the customer. This was done as a fair way to allocate prospective customers among different dealers and/or because it was assumed that a referral to the closest dealer would stand the best chance of resulting in a sale.

Admitted novel claim 1 recites a markedly different approach that is believed to enhance the likelihood that a sale will be made. A determination is first made as to whether the prospective customer had prior contact with any dealers. If so, the reason for each prior contact is located. A dealer that had a prior contact with the customer for the reason of **purchasing** is **given preference** in the automated referral **over** a dealer that had a prior contact with the customer for the reason of **servicing**. This is true even though the dealer that had the purchasing contact is further from the prospective customer than the one that had the servicing contact.

Wanker provides merchant comparison information and ranks the merchants based on weighting information. Col. 2, lines 33-38. The weighting information can include merchant-specific information such as “merchant service ratings 281,” “merchant response rating 282,” history of customer complaints 283,” evaluation of handling of complaints 284,” and “boycott information.” FIG. 2G.¹

However, and as correctly recognized in the office action, Wanker does not teach that prior contacts between the prospective customer and the merchants should be considered. Indeed, Wanker does not even teach receiving information about the identity of the prospective customer, thus making such a consideration impossible. The office action nevertheless urges that these seemingly large differences between claim 1 and Wanker were merely obvious ones.

The first reason offered in the office action for this conclusion is that Wanker “is shown to take prior contacts of all kinds.” As indicated above, Wanker does utilize a database containing “merchant service ratings 281,” “merchant response rating 282,” history of customer complaints 283,” evaluation of handling of complaints 284,” and “boycott information.” However, there is no suggestion in Wanker that the database contains the identity of the specific customers that were involved in each of these prior merchant contacts, let alone that their identify should be used in its ranking process. To the contrary, Wanker actually teaches away from the approach of admittedly-novel claim 1 -- ranking based on the nature of prior contacts that the prospective customer had -- by teaching that merchants should be ranked based on evaluations by others.

As noted in the office action, it is theoretically possible that a piece of the third party merchant data that is considered might originate from the prospective customer. However, and as also noted in the office action, Wanker's rankings are based on aggregated group data, not a single contact by an individual prospective customer. Indeed, looking only at a contact a merchant had with only one person would plainly run contrary to the obvious goal of Wanker to rate merchants based on aggregated data. To

¹ The office action also cites prior purchaser and consumer feedback information (item 274 in FIG. 2F). However, it is clear from the caption of FIG. 2F (“Product Information from Third Parties”), this information is about products, not merchants.

be sure, the office action does not offer any reason as to why this very substantial difference was merely an obvious one.

The only other reason offered in the office action as to why these substantial differences between amended claim 1 and Wanker were obvious is that "it would have been obvious . . . to ask for and receive this [contact] information so the customer could be contacted." This reason, however, in no way explains why it would have been obvious to have used this prior individual customer contact information in ranking dealers.

The office action also overlooks the very significant requirement in amended claim 1 that preference to be given to a dealer that had a prior contact with the customer for the reason of purchasing as contrasted to servicing. The office action does not contend that Wanker disclosed providing such a preference (and it clearly does not), nor does the office action offer any reason as to why this additional and substantial difference was merely an obvious one. As such, a *prima face* showing of obviousness has not even been presented. See "MPEP 2142 ("The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . 'rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'").

Independent claim 20 is a systems counterpart to independent claim 1 and is patentable in view of Wanker for comparable reasons.

Independent claim 23 has several similarities to claim 1, but gives preference to dealers that had a prior contact with the prospective customer over dealers that are closer to the prospective customer. As noted above in connection with claim 1, Wanker never determines whether the prospective customer had any prior contact with any of the merchants in the database. Nor does Wanker in any way suggest that a merchant who had a prior contact be given preference over a merchant who was closer to the prospective customer.

The office action fails to provide virtually any explanation as to why claim 23 is nevertheless obvious in view of Wanker. Indeed, it does not even state which elements in the claim are disclosed in Wanker, nor which elements are missing. It only states that “the system can be used more than once, thereby meeting the limitations as claimed.” Respectfully, the fact that Wanker could be used more than once is not a reason that explains why these very substantial differences between claim 23 and Wanker were obvious. Again, a *prima face* showing of obviousness has not been presented. See “MPEP 2142 (quoted above).

Independent claim 38 also has similarities to claim 1, but more generally gives preference to dealers who had a prior contact for one reason as compared to a prior contact for another reason. As noted above in connection with claim 1, Wanker never determines whether the prospective customer had any prior contacts with any of the merchants in the database, let alone the reasons for those prior contacts. Wanker also nowhere suggests that a prior contact with the prospective customer of one type be given priority over a prior contact of another type. The mere fact that the “merchant specific information collected by third parties” in FIG. 2G might contain a service rating, response rating, complaint, handling evaluation, or boycott information from the prospective customer in no way suggests that a prior contact with the prospective customer of one type should be given priority over a prior contact of another type. And again, the office action is devoid of any reason as to why this substantial difference was merely an obvious one.

Independent claim 39 is similar to independent claim 1, but gives preference to a seller who had a prior contact with the prospective customer as compared to a seller which did not. As noted above in connection with claim 1, Wanker never determines whether the prospective customer had any prior contacts with any of the merchants in the database. Wanker also nowhere suggests that a merchant who had a prior contact with the prospective customer be given priority over a merchant who did not. And again, no logical reason is provided as to why these marked difference were obvious.

The remaining claims are dependent upon one of these independent claims and thus are patentable for the same reasons given above.

Claims 18-19 and 36-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wanker as applied to claims 1-3, 10-16, 23-35, and 38-39 in view of Chislenko (U.S. Patent 6,041,311). Reconsideration and allowance are requested.

Claims 18-19 are dependent upon claim 1 and claims 36-37 are dependent upon claim 23. As explained above, claims 1 and 23 are patentable in view of Wanker because of deficiencies in this reference. Chislenko does not make up for any of these deficiencies.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this application is now in condition for allowance and early notice of the same is earnestly requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper or any other paper or matter in this application, including extension of time fees, to Deposit Account 501946, and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Marc E. Brown, Registration No. 28,590

**Please recognize our Customer No. 33401
as our correspondence address.**

600 13th St. NW
Washington DC 20005-3096
Phone: (310) 788-1569
Facsimile: (310) 277-4730
Date: June 2, 2011